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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,911	12/06/2001	Mark C. Waterbury	01241	7218
20879	7590	11/17/2003	EXAMINER	
EMCH, SCHAFER, SCHAUB & PORCELLO CO			ZIRKER, DANIEL R	
P O BOX 916			ART UNIT	
ONE SEAGATE SUITE 1980			PAPER NUMBER	
TOLEDO, OH 43697			1771	

DATE MAILED: 11/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- ☒ Responsive to communication(s) filed on 8/14/03
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- ☒ Claim(s) 1, 5-7, 14-25 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☒ Claim(s) 21 is/are allowed.
- ☒ Claim(s) 1, 5-7, 14-20, 23-25 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

### Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

### Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1, 5-7, 14-20, 23, 24, and claim 13 renumbered as claim 25 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, in claim 1, bottom paragraph, proper Markush language should be utilized to define the "one or more high polarity function groups" and it is also noted that as the claim now reads in the last line, "or" should be --and--, although this is not believed necessary with the utilization of Markush language. Newly "represented and currently amended" claim 13 was previously cancelled by applicants. No harm, however, is seen to applicants reintroducing the claim, which should be numbered as claim 25. In claim 18, the recitation of the adhesive layer as a high molecular weight acrylic acid appears improper since applicants have cancelled the "function group of an acid functionality" with their present response. Clarification is requested.

3. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth

the best mode contemplated by the inventor of carrying out his invention.

4. Claim 24 is rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. More particularly, although applicants' specification teaches at page 6, line 20 (and perhaps elsewhere) the presence of silicones in the release layer (applicants' "abherent" layer) nowhere in the specification <sup>are silicones</sup> ~~is it~~ taught as a member of the "adhesive" layer, and thus claim 24 would appear to either be new matter, or at the very least a violation of 35 U.S.C. § 112, first paragraph.

5. Claims 1, 5-7, 14-20, and 23-25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Spies et al., substantially for reasons already of record as further modified by the following observations. With respect to independent claims 1 and 23, the fact that Spies et al. discloses adhesives that are based on acrylic acid which is taught as particularly suitable by applicants' specification for the repulpable adhesive composition, is no longer pertinent in view of the fact that applicants have cancelled such adhesives which incorporate "one or more high polarity groups of an acid functionality." However, high polarity groups which feature "an ester linkage" remain as

particularly pertinent and it is known that both Examples 1 and 2 of Spies et al. feature repulpable self-adhesive compositions that can comprise 48% of butyl acrylate, which clearly reads upon this limitation. Accordingly, applicants' repeated arguments in their response that the reference fails to read on the claimed invention are simply again not understood. With respect to claims 5-7, as was previously set forth the presence of a water insoluble, discontinuous phase in either the substrate, adhesive layer or "abherent" layer or all three such layers read upon the presence of a wide variety of well known filler materials. As to claims 14, 15, 17, 19 and 20, as was previously set forth these are firmly believed to read upon well known elements such as soluble starches, ionic salts of polyacrylic acid, and water insoluble, discontinuous phases of cellulose fibers or high molecular weight acrylic acids which are still firmly believed to be well known to one of ordinary skill in the art. As to claim 16, the Examiner repeats his <sup>assertion</sup>~~reliance~~ that this is within the skill of the art and further cites Huber, column 9, lines 43-55, particularly lines 53-55 that lecithin is a well known release agent in the adhesive tape art such as was previously set forth in the final rejection, Paper No. 5. Similarly, it is further noted that the embodiment of claim 19 where the abherent layer includes a water insoluble discontinuous phase of polymethyl siloxane is believed well known to one of ordinary skill; i.e.

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note as evidence of the state of the art Nakamura et al., at column 2 line 66 - column 3 line 2, which the Examiner further relies upon as evidence of the state of the art. With respect to the Declaration of Zielske, the Examiner contests applicants' statements (faxed page 18) that applicants have met their burden of showing that the adhesives of Spies et al. do not meet applicants' test for being dissolvable, since nowhere is an objective comparison made, either in the specification or in the submitted Declaration. With respect to Ms. Zielske's observations at page 18, second full paragraph, that the repulpable release layer of Spies et al. must be silicone free, whereas applicants' abherent layer includes silicones, is not agreed with, since nowhere in any of the independent claims can this limitation be found. Finally, with respect to Declarant's observation (faxed page 18, bottom paragraph) that Spies et al. fails to disclose or suggest an adhesive layer using the linkages applicants claimed, namely the functionalities set forth in the <sup>independent</sup> claims the Examiner can only note that the reference teaches in both examples the presence of butyl acrylate as comprising almost half of the repulpable self-adhesive composition. As to applicants' remarks concerning Huber, the Examiner again repeats that this reference is relied upon only as evidence of the state of the art that lecithin is well known in the state of the art as a dissolvable release composition. Other parameters that are not

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either expressly or inherently disclosed are each still believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

6. Claim 21 remains allowed.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

November 12, 2003

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1300-  
1700

*Daniel Zirker*